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RE	FSP0293 APPEAL BRIEF

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Attorney Docket Number: FSP0293  
Client Reference Number: 267654US  
Title: providing advertising after a video program has been paused  
Application Number: 10/693,280  
Filing Date: Thursday, October 23, 2003

17 pages of appeal brief  
1 page of Certificate of facsimile  
1 page of Petition for extension of time to reply  
1 page of Fee transmittal to PTO  
Authorization to debit deposit account 501691 for \$1030 dollars.

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Attorney Docket Number: FSP0293  
Title: providing advertising after a video program has been paused  
Application Number: 10/693,280

**APPEAL BRIEF**

for

Attorney Docket Number: FSP0293  
Client Reference Number: 267654US  
Title: providing advertising after a video program has been paused  
Application Number: 10/693,280  
Filing Date: Thursday, October 23, 2003

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Appeal is taken from the Examiner's most recent office action mailed on 10/02/2008; this was a pre-appeal decision on a response by the Applicant filed on June 29, 2008.

This appeal brief complies with the revised format specified in MPEP 1205.

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**REAL PARTY IN INTEREST**

The real party in interest is

Broadband Royalty Corporation  
1105 North Market St.  
Suite 1300  
Wilmington, DE, USA

the assignee and/or owner of all rights and interest in the subject matter of this appeal.

Attorney Docket Number: FSP0293  
Title: providing advertising after a video program has been paused  
Application Number: 10/693,280

**RELATED APPEALS AND INTERFERENCES**

None.

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### **STATUS OF CLAIMS**

In the most recent office action, Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0226142 by Rand.

Claims 1-27 are the subject of this appeal.

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Application Number: 10/693,280

### **STATUS OF AMENDMENTS**

No amendments were filed after final rejection.

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### **SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 describes a method for inserting advertising into a video program. The method includes providing a still image from the video program when the video program has been paused, combining an advertisement image with the still image thereby forming the combined image, and providing the combined image. Page 1, line 25 – Page 2, line 2. Page 2, line 27 – Page 4, line 9.

Independent claim 12 describes a system for inserting advertising into a video program. The system includes a means for providing a still image from the video program when the video program has been paused, a means for combining an advertisement image with the still image, and a means for providing the combined image. Page 2, line 27 – Page 4, line 9. Page 5, line 26 – Page 8, line 3.

Independent claim 23 describes a system that includes a stream server for providing a video program, a combiner for combining a still image from the video program with an advertising image to produce a combined image, and a client device for providing the combined image to a viewer. Page 2, line 27 – Page 4, line 9. Page 5, line 26 – Page 8, line 3.

Independent claim 27 describes a system that includes video content for providing a video program, a combiner for combining a still image from the video program with an advertising image to produce a combined image, and a device for providing the combined image to a viewer. Page 2, line 27 – Page 4, line 9. Page 5, line 26 – Page 8, line 3.

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**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Are claims 1-27 anticipated under 35 U.S.C. 102(e) by U.S. Patent Application Publication No. 2003/0226142 to Rand?

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### ARGUMENTS

The most recent Official Action holds to the position that Rand discloses combining content with a still image when pausing the video program, citing paragraphs [0010-0011] and [0028-0032]. It is alleged that these sections demonstrate that Rand's invention relates to the selective insertion of media items (e.g., advertising, passive item) into a media stream. It is alleged that these paragraphs also discuss how Rand's invention is to insert media items (e.g., by halting the delivery of content-see [0029-0030]). The Applicant will now traverse the Rand rejection in detail.

Each of independent claims 1, 12, 23 and 27 of the present application recites in some fashion the following features:

providing a still image from the video program when the video program has been paused;  
combining an advertisement image with the still image thereby forming the combined image; and providing the combined image.

The claims set forth, inter alia, three features of note in this Appeal:

1. providing a still image from the video program when the video program has been paused;
2. combining an advertisement with the still image that was provided when the video program was paused;
3. forming a combined image of the advertisement and the still image that was provided when the video program was paused.

These features will henceforth be described, respectively, as features 1-3 of the claims.

Rand, Paragraph 10, recites:

[0010] The present invention is also directed to the selective insertion of media items into a media data stream provided to an individual viewer or to designated groups of viewers. The media stream can be a video stream, an audio stream, or a combination thereof. The inserted

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item can also be an interactive application of possibly indeterminate length, a link to a website, a computer generated animation, or a passive item with a hot-button by which a user can request further information.

Rand, Paragraph 11 recites, inter alia:

[0011] ... The invention enables a service provider to selectively insert—advertising, commercial, or other content into a media stream on a subscriber by subscriber basis, ...

The Applicant respectfully contends that nowhere in paragraphs 10 or 11 (or anywhere else in Rand) are features 1-3 of the independent claims disclosed. Specifically, there is no teaching of 1) providing a still image from the video program when the video program has been paused, (2) combining an advertisement with the still image that was provided when the video program was paused, or 3) forming a combined image of the advertisement and the still image that was provided when the video program was paused.

The Official Action also cites Paragraphs 28-32 of Rand. Rand, Paragraph 28 recites, inter alia:

[0028] ... Depending on preferences entered by the subscriber, the provider can insert commercial material into this customized stream, as previously described.

Here Rand is merely describing the well-known process of “ad splicing”, in which a portion of a stream reserved for advertising content is overwritten with add content at delivery time. Rand, Paragraph 29 recites, inter alia:

[0029] A subscriber or provider can also specify a customized stream for future delivery. For example, a provider’s server can create an anthology of the best sequences of a particular television series with a new soundtrack. This anthology can be created either by the provider on its own initiative, or in response to a subscriber request. Rather than

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duplicating those parts of the anthology that are copied, the system of the invention will store pointers to the inserted segments in a permanent storage device, along with the new sound track. These pointers will be resolved at run-time, after a subscriber has requested delivery of the anthology. The subscriber can also specify that the customized data stream be delivered to a subscriber other than the requesting subscriber. The customization of a data stream can also be performed dynamically. For example, a movie with multiple endings can prompt the subscriber to make a selection during the delivery of the movie. The subscriber's selection will determine which segment the server will subsequently deliver to the subscriber.

Here Rand is merely describing the well-known process of "stream customization", in which the exact content of a media stream is resolved at delivery time.

Rand, Paragraph 30 recites, inter alia:

[0030] ..An STB 110 queries manager 120 for content F1131, after which manager 120 instructs video server 130 to stream F1131 to SIB 110. Manager 120 then checks meta-data 135 to find an insert point in F1131. Meta-data 135 can be, for example, a library or database of suitable insertion locations for each item contained on server 130. Once the insertion point is found, manager 120 instructs video server 130 to halt delivery of content F1131 and send content F2132 to STB 110. After content F2132 has been sent, manager 120 instructs server 130 to resume delivery of content F1131.

Here Rand is merely describing the process of inserting content into a data stream, by halting the stream, sending the content to insert, and then resuming the stream.

Paragraphs 31-32 of Rand merely recite that the inserted content may be an alternate ending to a movie, or content specifically requested by a STB:

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[0031] Alternatively, content F1131 can be a movie with a different ending F2132. At some time during the delivery of F1131 to STB 110, the subscriber will be prompted to make a choice. This choice will be transmitted to manager 120, which will then instruct server 130 whether to continue the delivery of content F1131 or start delivery of content F2132 instead.

[0032] In a third alternative, STB 110 may request that manager 120 send content F1131 followed by content F2132. Manager 120 will then instruct server 130 to send the requested content to STB 110.

Nowhere in the cited sections of Rand, or anywhere else in the reference, can one find a teaching of 1) providing a still image from the video program when the video program has been paused, (2) combining an advertisement with the still image that was provided when the video program was paused, or 3) forming a combined image of the advertisement and the still image that was provided when the video program was paused. Rand doesn't describe, address, or imply these features.

The Applicant respectfully requests that the rejection over Rand be withdrawn, and that all of the claims allowed.

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### CLAIMS APPENDIX

1. A method for inserting advertising into a video program comprising: providing a still image from the video program when the video program has been paused; combining an advertisement image with the still image thereby forming the combined image; and providing the combined image.
2. The method of claim 1, further comprising waiting a first configurable amount of time after the video program has been paused to provide the combined image.
3. The method of claim 1, wherein the video program includes audio.
4. The method of claim 1, further comprising: performing a trick function on the video program; presenting a new still image from the video program after the trick function has been performed; waiting an additional configurable amount of time after the trick function has been performed; and presenting the combined image after the additional configurable amount of time has passed.
5. The method of claim 1, wherein the still image comprises an image from the video program and an additional image.
6. The method of claim 1, wherein the video program continues to play.
7. The method of claim 1, comprising the additional step of ceasing to provide the combined image.
8. The method of claim 7, wherein said ceasing is performed after a second configurable amount of time.
9. The method of claim 7, wherein the advertisement image is an advertisement video program and the advertisement video program finishes, before the said ceasing.

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10. The method of claim 1, wherein a series of advertisement images are provided.
11. The method of claim 1, further comprising recording billing information after an advertisement image is provided.
12. A system for inserting advertising into a video program that comprises: a means for providing a still image from the video program when the video program has been paused; a means for combining an advertisement image with the still image; and a means for providing the combined image.
13. The system of claim 12, wherein the system waits a first configurable amount of time after the video program has been paused; and then provides the combined image.
14. The system of claim 12, wherein the video program includes audio.
15. The system of claim 12, that further comprises: a means for performing a trick function on the video program; a means for providing a new still image from the video program after the trick function has been performed; waits an additional configurable amount of time after the trick function has been performed; and a means for providing the combined image after the additional configurable amount of time has passed.
16. The system of claim 12, wherein the still image comprises an image from the video program and an additional image.
17. The system of claim 12, wherein the video program continues to play.
18. The system of claim 12, wherein the combined image ceases to be provided.
19. The system of claim 18, wherein the said ceasing is performed after a second configurable

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amount of time.

20. The system of claim 18, wherein the advertisement image is an advertisement video program and the advertisement video program finishes, before the video program is stopped.

21. The method of claim 12, wherein a series of advertisement images are provided.

22. The method of claim 12, further comprising a means for recording billing information after the advertisement image is provided.

23. A system comprising: a stream server for providing a video program; a combiner for combining a still image from the video program with an advertising image to produce a combined image; and a client device for providing the combined image to a viewer.

24. The system of claim 23, wherein the stream server comprises: the combiner; VOD content; and advertisement content which provides the combiner with the advertisement image.

25. The system of claim 23, wherein the client device comprises: the combiner and advertisement content that provides the combiner with the advertisement image.

26. The system of claim 23, wherein the client device comprises a combiner and a VOD server provides the advertisement image to the combiner.

27. A system comprising: video content for providing a video program; a combiner for combining a still image from the video program with an advertising image to produce a combined image; and a device for providing the combined image to a viewer.

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## **EVIDENCE APPENDIX**

None

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#### **RELATED PROCEEDINGS APPENDIX**

None

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Respectfully Submitted by:

Signature /Charles A. Mirho/

Date: 12/20/2008

Charles A. Mirho

Reg. 41,199

Attorney for Applicant

Address all correspondence to:

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Phone: 360-737-1748

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

for

Attorney Docket Number: FSP0293

Client Reference Number: 267654US.

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Application Number: 10/693,280

Filing Date: Thursday, October 23, 2003

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I hereby certify that the following is being transmitted via facsimile to telephone number 571-273-8300 on Saturday, December 20, 2008.

Signature: /Charles A. Mirho/  
Charles A. Mirho

**Contents of This Correspondence**

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17 pages of appeal brief

1 page of Certificate of facsimile

1 page of Petition for extension of time to reply

1 page of Fee transmittal to PTO

Authorization to debit deposit account 501691 for \$1030 dollars.

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**PETITION FOR EXTENTION OF TIME UNDER 37 CFR 1.136(a)**

Attorney Docket Number: FSP0293

Client Reference Number: 267654US

Title: providing advertising after a video program has been paused

Application Number: 10/693,280

Filing Date: Thursday, October 23, 2003

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This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application.

The requested extension and appropriate fee are as follows:

Fee under 37 CFR 1.17(a) for an extension of 2 months: \$490 dollars.

Authorization to debit deposit account 501691 for \$1030 dollars is included and includes amounts to cover the statutory fees for the requested extension months.

Credit overpayments and charge unpaid fees to deposit account 501691.

I have enclosed a duplicate copy of this sheet. I am the attorney or agent of record (see below).

Signature     /Charles A. Mirho/  
                 Charles A. Mirho  
                 Reg. 41,199  
                 Attorney for Applicant

Date: Saturday, December 20, 2008

Address all correspondence to:  
FSP LLC  
Attn: Charles A Mirho  
P.O. Box 890  
Vancouver, WA 98666-0890  
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Phone: 360-737-1748  
Fax: 360-294-6426

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Signature      /Charles A. Mirho/  
Charles A. Mirho  
Reg. 41,199  
Attorney for Applicant

Date: Saturday, December 20, 2008

Address all correspondence to:

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**\*\*Duplicate\*\***

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**FEE TRANSMITTAL**

for

Attorney Docket Number: FSP0293  
Client Reference Number: 267654US  
Title: providing advertising after a video program has been paused  
Application Number: 10/693,280  
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TOTAL FEE: \$1030 dollars

This fee includes:

USPTO statutory fee to file an appeal brief: \$540

USPTO statutory fee for extension of statutory period of reply by two months: \$490

Payment is made by Authorization to debit deposit account 501691 for \$1030 dollars.  
PLEASE NOTE **FSP0293** AS THE ATTORNEY DOCKET NUMBER ASSOCIATED  
WITH THIS TRANSACTION.

Charge unpaid fees and credit overpayments to deposit account 501691. PLEASE NOTE  
**FSP0293** AS THE ATTORNEY DOCKET NUMBER ASSOCIATED WITH THIS  
TRANSACTION ON THE DEPOSIT ACCOUNT STATEMENT.

Submitted by:

Signature     /Charles A. Mirho/  
                 Charles A. Mirho  
                 Reg. 41,199  
                 Attorney for Applicant

Date: Saturday, December 20, 2008

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